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PATENT, TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION

Docket No.: 0163-0758-0X

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/556,127
Applicants: Ryuichiro KURANE et al
Filing Date: April 20, 2000
For: METHOD FOR DETERMINING A CONCENTRATION OF TARGET NUCLEIC ACID MOLECULES, NUCLEIC ACID PROBES FOR THE METHOD, AND METHOD FOR ANALYZING DATA OBTAINED BY THE METHOD
Group Art Unit: 1655
Examiner: FREDMAN

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT

Our check in the amount of is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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0163-0758-0X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#7
Harry
2-23-01

IN RE APPLICATION OF:

RYUICHIRO KURANE ET AL

SERIAL NO: 09/556,127

FILED: APRIL 20, 2000

EXAMINER: FREDMAN

GROUP ART UNIT: 1655

FOR: METHOD FOR DETERMINING A CONCENTRATION OF TARGET NUCLEIC ACID MOLECULES, NUCLEIC ACID PROBES FOR THE METHOD, AND METHOD FOR ANALYZING DATA OBTAINED BY THE METHOD

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the Official Action mailed January 23, 2001, Applicants elect, with traverse, Group II, Claims 2-11, 15, 21 and 23-26 for further prosecution.

REMARKS

The Office has restricted this application as follows under 35 U.S.C. §121:

Group I: Claims 1, 12-14, 19, 20, 22 and 27-32;

Group II: Claims 2-11, 15, 21 and 23-26; and

Group III: Claims 16-18 and 33-45.

Applicants have elected Group II, Claims 2-11, 15, 21 and 23-26 with traverse.

Restriction is only proper if the inventions of the restricted groups are either independent or patentably distinct, and there is a burden in searching the entire application.

MPEP §803. Applicants respectfully traverse the Restriction Requirement on the grounds that the Office has not provided an adequate reason or example to support a conclusion of patentable distinctness, or shown that a burden exists in searching the entire application.

The inventions of Group II and Groups I and III have been characterized by the Office as a product and a process of use. The Office attempts to demonstrate patentable distinctness by stating that the product of Group II can be used in a materially different process, such as DNA purification methods.

The Office does not offer any additional evidence to conclude that the claimed invention can be used as suggested. Furthermore, even if the claimed product could be used as suggested, the Office has not shown how the suggested process is materially different from the claimed invention. Therefore, the Restriction Requirement between the inventions of Groups I, II and III is improper and should be withdrawn.

Applicants further traverse the Restriction Requirement on the grounds that it would cause no undue burden on the Office to examine all claims. MPEP §803 states as follows:

> If the search and examination of an entire application can be made without serious burden, the Examine must examine it on its merits, even though it includes claims to distinct or independent inventions.

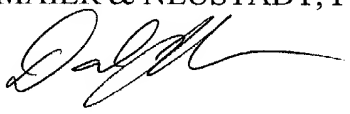
Applicants submit that a search of all claims would not constitute a serious burden on the Office.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn. Applicants further submit that this application is now

ready for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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